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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,794	12/29/2000	Dennis M. Briddell	062891.0464	5316

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EXAMINER

VINCENT, DAVID ROBERT

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,794

Applicant(s)

BRIDDELL ET AL.

Examiner

David R Vincent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Claim Objections

1. Claims 1-10 are objected to because of the following informalities:

Claim 1 specifies traffic carrying ATM cells. Claim 4 specifies "traffic not being carried by ATM cells". This phraseology is confusing. The applicant should use consistent terms.

Claim 1 specifies "identify each traffic carrying ATM cell". Does the applicant mean to say identify data within the traffic or identify ATM cells within the traffic?

Claim 9, specifies the encapsulation frames, and the applicant probably meant to say encapsulated frames/cells. Appropriate correction is required.

Claims 1-4, 6-8, and 10 specify the phrase "operable to" which is equivalent to saying adapted to. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for the term "the serial communication unit" claim 3, line 5-6.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickali (US 5,619,500), in view of Stallings 1999 ISDN/ATM text book.

The applicant uses very broad and somewhat confusing language in the claims (see above). Also there are claims, e.g., 1, 11, and 20 that specify the phrase "readable by" but never say where the encapsulated frames go if anywhere.

Meaning, at least those claims do not specify that the frames

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ever get to a serial controller, and as such do not say how many transitions might take place along the way.

As shown in Figs. 1-10, Hickali (US 5,619,500) discloses a device (301/302) for interworking ATM cells comprising a TC sublayer (ATM adaptation layers/AAL using convergence sublayers in 573, 533, Fig. 5; col. 3, lines 19-25; col. 5, lines 5-27), identifying ATM cells (col. 4, lines 25-36, especially lines 32-33), an encapsulation unit (e.g., 302, col. 3, lines 19-21; Fig. 3 or 539, Fig. 5 encapsulates data; encapsulating is related to creating ATM cells and using the various AAL layers; the traffic output on the ATM cell bus is encapsulated) using a protocol that readable by a serial communications controller (SCC not further defined; 301,302 uses TDM, T1s e.g., col. 3, lines 3-25; and serial lines, col. 9, lines 28-35; the controller reads on a microprocessor, 536 or any device controlling the gateway; HDLC controller 800, cols. 11-12), a framer (533, 573, Fig. 5) receiving from a trunk line (e.g., T1s, cols. 2-3; Fig. 3) "operable to" provide data to a sublayer (col. 3, lines 19-25; col. 5, lines 5-27; the framer is not further defined and reads on 533, 573 and any device that prepares traffic for transmission), controller unit (573/533) "operable to" receive traffic from the framer and provide it to a serial communications unit (HDLC unit in 533/573), select the traffic

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not being carried by ATM cells (not clear what applicant means here but clearly the controller units in 570, 573, 533, and 530 do accept non-ATM traffic Fig. 3 and Frame Relay traffic, Fig. 3, col. 3, lines 3-25; claim 4 does not specify where the data is going), and a sublayer and encapsulation unit (533, 573) are "operable to" receive programming commands (they receive commands from the data itself since a plurality of type of data are being received by the gateway and there are inherent fields which identify what type of data is being received, Fig. 3) to change a capability (reads on almost any field that is in a frame or cell headers because header data is essentially programming the receiving devices, e.g., synchronizing dealing with HEC fields or timing dealing with SRTS in AAL1 fields, type information, CLP bit dealing with cell loss priority and whether a device is allowed to receive and transmit a cell when it is experiencing congestion) of a device (gateway 302). However, Hickali does not particularly call for term encapsulation, as specified in claims 1, 11, and 20 and the details of how HEC works and discards data/cells, therefore, fails to call for the limitations of discarding et. In claims 6-8, and 14-17.

Stallings teaches how when using ATM traffic is encapsulated by using ATM adaptation layers (AALs) and convergence sublayers (PP: 438-446, and 450, especially pages

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directed towards AAL which is used for TDM/T1 line data) HEC works and how it would have been obvious to discard cells (fixed length frames, PP: 427-434, and 450, especially page 430, Fig. 16.8, and Fig. 16.7, pg. 429 where cell discarding is mentioned). It would have been obvious to comply with the ATM HEC algorithm for the sake of interoperability with other ATM units and to assure proper synchronization and accuracy, especially since Hickali discloses using HEC (573, 533, Fig. 5; col. 6, lines 36-58).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R Vincent whose telephone number is 703 305 4957. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on 703 305 4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David R Vincent
Primary Examiner
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May 26, 2004